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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,986	05/16/2005	Makoto Fujii	272482US0PCT	1900
22850	7590	11/03/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MERCIER, MELISSA S	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/534,986

Applicant(s)

FUJII ET AL.

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-16-05 8-9-05</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### **Summary**

Claims 1-3 and 6 are pending in this application. Applicant has canceled claims 4-5. Claims 1-3 and 6 are rejected.

### ***Priority***

Applicants claim of Priority to PCT/JP03/14249 filed on November 10, 2003 is acknowledged.

### ***Information Disclosure Statement***

Receipt of Applicants Information Disclosure Statements filed on May 16, 2005 and August 9, 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1-3 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Shiroyama (EP 1 153 595 A2).

Shiroyama teaches a "clear aqueous composition comprising a ceramide, a long chain fatty acid having 12-24 carbon atoms, a nonionic surfactant, and water. The composition is useful for cosmetics" (abstract). Isostearic acid is disclosed as a suitable long chain fatty acid. Shiroyama further teaches the addition of a sterol compound. (paragraph 0013).

Regarding Claim 2, polyoxyethylene hydrogenated castor oil is disclosed as the nonionic surfactant (paragraph 0013).

Regarding Claim 3, Shiroyama discloses, the weight ratios of ceramide to the long chain fatty acid is 20:1 to 1:3, while the reference does not teach a sterol and fatty acid combined within the weight ratios, it would be within the knowledge of a person of

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ordinary skill in this art to expand upon the teachings of Shiroyama in order to produce a product with the desired properties. Shiroyama teaches the effects of adding too much ceramide (not economical and does not improve stability), too much fatty acid component (stability of the system deteriorates). Applicant would have the ability to modify the amounts of each component to yield a suitable product through routine experimentation with the teachings of Shiroyama.

Regarding Claim 6, Shiroyama does not specifically disclose the use of polyoxyethylene (60) hydrogenated castor oil, however, he does disclose suitable nonionic surfactants can include polyoxyethylene hydrogenated castor oil derivatives. It would be within the knowledge of a person of ordinary skill in the art to choose a derivative that would give the qualities, properties and results desired.

Shiroyama does not disclose a mean particle diameter for the emulsion. However, it would have been within the knowledge of the person of ordinary skill in this art to adjust and set the desired particle size in order to make an emulsion, which would meet their desired qualities and properties.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have expanded upon the teachings of Shiroyama in order to create a semitransparent cosmetic composition which is excellent in clearness and feel of use, because Shiroyama's preferred embodiment discloses, a clear aqueous ceramide composition comprising a lipid composition comprising a ceramide, isostearic acid, at least one polyoxyethylene hydrogenated castor oil, water, a sterol and a polyhydric alcohol. It is noted that applicant utilizes the terminology "comprising" in claim

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1, which would allow for the inclusion of additional components, such as the polyhydric alcohol (paragraph 0038).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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